

REMARKS

Claim 137 is currently amended. Claims 1-127, 131 and 140 have been cancelled. Claims 134-136 and 143-145 have been withdrawn. Claims 128-130, 132-133, 137-139, and 141-142 are currently under examination. Reconsideration of the application in view of the current claims is respectfully requested and further in view of the following Remarks.

I. INFORMATION DISCLOSURE STATEMENT

Applicants acknowledge, with appreciation, the Examiner's indication that the references submitted in the Information Disclosure Statement filed March 31, 2008 have been considered.

II. INTERVIEW SUMMARY

Applicants thank Examiner Negin for his courtesy during the interview of August 22, 2008, attended in person by Esther Kepplinger and by phone by John Storella. Applicants proposed an amendment to claim 137 to overcome the rejection for lack of patentable subject matter. Applicants also argued that the written description requirement had been improperly applied to claims 131 and 140, and that the Rappaport reference did not anticipate the claimed invention because it did not show the use of an evidence-based medicine filter.

III. CLAIM REJECTIONS UNDER 35 U.S.C. § 101

The Examiner has rejected claims 137-142 under 35 U.S.C. §101 as drawn to non-statutory subject matter (Office Action, pages 3-4). The Examiner asserts that:

Claims 137-142 are drawn to computer readable media wherein page 6 of the specification (line 1-3) specifically states that the computer readable media encompasses carrier waves (i.e. signals), which, per se, are not statutory. See MPEP 2106. As the claims encompass embodiments which are nonstatutory subject matter, claims 137-142 are not statutory.

Applicants dispute the Examiner's position that carrier waves are not statutory subject matter. Nevertheless, in order to advance prosecution and without waiving Applicants' right to pursue such subject matter in related applications, Applicants have amended claim 137 to exclude "carrier waves" as a form of computer readable medium. Because carrier waves are explicitly recited in the specification, it

is proper to specifically exclude them from the claims. (See, e.g., MPEP 2173.05(i).) In view of Applicants' amendment, Applicants request the Examiner withdraw his rejection of claims 137-142 under 35 U.S.C. §101 as being drawn to non-statutory subject matter.

IV. CLAIM REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

The Examiner has rejected claims 131 and 140 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner asserts that:

Since step b of instant claim 128 involves "translating the genetic profile into one or more identifiers of a medical literature classification system for a medical literature database," and dependent claim 131 is further limiting where the medical literature classification system includes MeSH, instant claim 131 lacks written description because MeSH is continuously being updated and applicant does not have possession of MeSH in its current, or any future (updated) form. In other words, the translating step involves searching databases in the form of MeSH present at the time of filing; applicant (at the time of filing) did not have possession of MeSH in any updated form.

The Examiner continued that the same type of analysis applies to claim 140. Applicants request reconsideration.

One purpose of the written description requirement is to show that Applicants were in possession of the invention at the time the application was filed. The Examiner concedes that at the time the Applicants filed the application they had possession of the invention of using MeSH to search databases. The inquiry properly stops here with a finding that the specification did, indeed provide a written description of the use of MeSH.

Requiring Applicants to show they had possession of how the invention might be applied in the future is an improper application of the written description requirement: Applicants are not aware of any legal authority that supports this interpretation of the standard, nor has the Examiner supplied evidence of any such authority.

Nevertheless, in order to advance prosecution, and recognizing that the independent claims cover the use of medical literature classification systems without limitation, Applicants have cancelled claims 131 and 140.

In view of this amendment, Applicants respectfully request the Examiner to withdraw the rejection.

V. CLAIM REJECTIONS UNDER 35 U.S.C. § 102

The Examiner has rejected claims 128, 129, 132, 133, 137, 138, 141 and 142 under 35 U.S.C. § 102(b) as being anticipated by Rappaport (U.S. PGPUB 2002/0007285, hereinafter "Rappaport"). The Examiner argued, among other things, that Rappaport's Evidence Database corresponded to a medical literature database of the claims and that Rappaport showed searching the Evidence Database with a filter based on relevance to evidence-based medicine.

In order for Applicants' claims to lack novelty under 35 U.S.C. § 102 (i.e., be anticipated), each and every element of the claimed invention must be disclosed in a single prior art reference. *Akzo N.V. v. U.S. International Trade Comm'n*, 808 F.2d 1471 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987); see also *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565 (Fed. Cir. 1986); *In re Paulson*, 30 F.3d 1475 (Fed. Cir. 1994); *Rowe v. Dror*, 112 F.3d 473 (Fed. Cir. 1997) ("A prior art reference anticipates a claim only if the reference discloses every element of the claim." *Emphasis added*).

Applicants traverse on the grounds that Rappaport failed to show at least the following elements of the claims: The step of "(c) searching the medical literature database for medical literature articles relating to the one or more identifiers using an evidence based medicine filter" or computer code that carried out that step.

Rappaport discussed searching the Evidence Database using information corresponding to query criteria, e.g., based in information about a medical procedure performed on a patient. (See Rappaport, paragraphs [0021] and [0022].) The Examiner stated, "Since the database of information being searched is a database of evidence based on medicine resources ... the retrieved articles are filtered based on relevance to evidence-based medicine." (Office action, page 6.)

Applicants do not agree with this conclusion. While Rappaport described searching the Evidence Database using query criteria, the criteria did not employ and need not have employed an evidence based medicine filter.

A filter, by definition, is a tool that includes desired items and excludes undesired items. The Examiner stated that Rappaport's Evidence Database is a database of evidence based medicine resources. It is a database of pre-selected contents from other sources. It follows that medical literature that did not relate to evidence based medicine was already excluded from the Evidence Database. Accordingly, Rappaport's search of the Evidence Database using query criteria did not involve searching with an evidence based medicine filter. There would have been no reason to employ such a filter because there were no articles to "filter out." Indeed, Applicants find no mention in Rappaport of using an evidence based medicine filter on the Evidence Database.

Because it did not disclose every element of the claims, Rappaport did not anticipate the present invention. Applicants request the Examiner to withdraw the rejection.

VI. CLAIM REJECTIONS UNDER 35 U.S.C. § 103(A)

A. Claims 130 and 139 have been rejected under 35 U.S.C. § 103(a) over Rappaport as applied to claims 128, 128, 132, 133, 137, 138, 141 and 142, in further view of Davies et al. (US PGPUB 2003/0046114, hereinafter "Davies et al.")

The Examiner has rejected claims 130 and 139 under 35 U.S.C. § 103(a) as being unpatentable over Rappaport as applied to claims 128, 128, 132, 133, 137, 138, 141 and 142 in further view of Davies et al. The Examiner asserts that Davies et al. disclose patient profiles including SNP information (for example, paragraph 19, paragraph 68). Applicants traverse.

Without taking a position on the Examiner's interpretation of Davies et al., Applicants note the following. Applicants demonstrated above that Rappaport failed to show every element of the claimed invention. Davies et al. did not supply the missing elements. Therefore, the combination of Davies et al. with Rappaport could not have rendered any claim, independent or dependent, obvious.

B. Claims 131 and 140 have been rejected under 35 U.S.C. § 103(a) over Rappaport as applied to claims 128, 128, 132, 133, 137, 138, 141 and 142 in further view of McCray et al. (Proc AMIA Symp., 2002, pages 504-508), hereinafter “McCray et al.”)

The Examiner has rejected claims 131 and 140 under 35 U.S.C. § 103(a) over Rappaport as applied to claims 128, 128, 132, 133, 137, 138, 141 and 142 in further view of McCray et al. The Examiner argued that one of the databases taught in McCray et al. is the MeSH database. Applicants traverse.

Without taking a position on the Examiner’s interpretation of McCray et al., Applicants note the following. Applicants demonstrated above that Rappaport failed to show every element of the claimed invention. McCray et al. did not supply the missing elements. Therefore, the combination of McCray et al. with Rappaport could not have rendered any claim, independent or dependent, obvious.

For these reasons, Applicants request the Examiner to withdraw the rejections for obviousness.

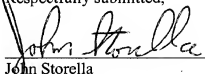
CONCLUSION

For the foregoing reasons, Applicants request the Examiner allow the claims and advance the application to issuance.

FEE AUTHORIZATION

The Commissioner is authorized to charge any additional fees which may be required, including petition fees and extension of time fees, to Deposit Account No. **23-2415** (Docket No. 29954-701.201).

Date: August 26, 2008

Respectfully submitted,

By: John Storella
Registration No. 32,944

WILSON SONSINI GOODRICH & ROSATI
650 Page Mill Road
Palo Alto, CA 94304-1050
Direct Dial: (650) 849-3245
Customer No. 21971